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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/978,636	11/25/1997	ELAZAR RABBBANI	ENZ-53(DIV-3	4642
28170	7590	12/09/2004	EXAMINER	
ENZO DIAGNOSTICS, INC. C/O ENZO BIOCHEM INC. 527 MADISON AVENUE 9TH FLOOR NEW YORK, NY 10022			SCHULTZ, JAMES	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/978,636

Applicant(s)

RABBBANI ET AL.

Examiner

J. D. Schultz, Ph.D.

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 November 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is/ (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 248 for reasons of record.

Claim(s) rejected: 245-247, 249-255, and 258-261 for reasons of record.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: Applicant's proposed amendment will not be entered because said amendment seeks to add claim language that improperly broadens the scope of the claims to newly embrace embodiments not previously searched. For example, the amendment changes the intron of the claimed construct from a non-native intron to any intron. Said amendment broadens the claim to a scope that had not been previously searched, and therefore raises new issues which require new considerations.

Continuation of 5. does NOT place the application in condition for allowance because: the arguments contained therein are drawn solely to the claims as they exist in the proposed amendment, which has not been entered for reasons outlined above. Applicants present no other arguments, and accordingly the request for reconsideration is not convincing.

Continuation of 10. Other: See attached Notification of Non-Compliance regarding the sequence listing submitted November 19, 2004..

JOHN L. LEGUYADER  
SUPERVISOR EXAMINER  
TECHNOLOGY CENTER 1600

Application No.: 08/978,636B

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING  
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☒ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: See attached Problem Report

**Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

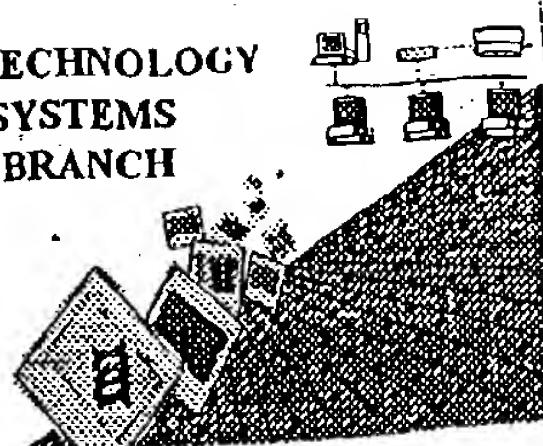
For CRF Submission Help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856

**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE**

1FW16

BIOTECHNOLOGY  
SYSTEMS  
BRANCH



## CRF Problem Report

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) experienced a problem when processing the following computer readable form (CRF):

Application Serial Number:

08/978,636B

Filing Date:

11/25/97

Date Processed by STIC:

11/24/04

STIC Contact: Mark Spencer: Telephone: 571-272-2510; Fax: 571-273-0221

### Nature of Problem:

The CRF (was):

☐ (circle one) Damaged or Unreadable (for Unreadable, see attached)

☐ Blank (no files on CRF) (see attached)

☐ Empty file (filename present, but no bytes in file) (see attached)

☒ Virus-infected: Virus name: \_\_\_\_\_ The STIC will not process the CRF

☐ Not saved in ASCII text

☐ Sequence Listing was embedded in the file. According to Sequence Rules, submitted file should **only** be the Sequence Listing.

☒ Did not contain a Sequence Listing. (see attached sample)

☐ Other: \_\_\_\_\_

**PLEASE USE THE CHECKER VERSION 4.2 PROGRAM TO REDUCE ERRORS.**

**SEE BELOW FOR ADDRESS:**

<http://www.uspto.gov/web/offices/pac/checker/chkrnote.htm>

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail.

~~Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom.~~

Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<<http://www.uspto.gov/efc/efs/downloads/documents.htm>> , EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
3. Hand Carry, Federal Express, United Parcel Service, or other delivery service (EFFECTIVE 06/05/04):  
U.S. Patent and Trademark Office, 220 20<sup>th</sup> Street S., Customer Window, Mail Stop Sequence, Crystal Plaza Two, Lobby, Room 1B03, Arlington, VA 22202

Revised 05/19/04

[illegible]

a directory (empty) named "Trashes" was on submitted disk and another directory "501" (empty) (see above sample) was also on it.